

REMARKS

Claims 2-8, 11-13, 15, 18-22, 29-33, and 35-40 were pending in the present application. In the above amendments, claims 29, 33, 35 and 36 are amended. No claims are canceled and no new claims are added. Therefore, after entry of the above amendments, claims 2-8, 11-13, 15, 18-22, 29-33, and 35-40 are pending in this application for reconsideration. Applicant believes that the present application is now in condition for allowance, which prompt and favorable action is respectfully requested.

Summary of the Office Action

In the Office Action, claims 2-8, 11-13, 15, 18-22, 29-33, and 35-40 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,914,695 to Walters et al. (“Walters”) in view of U.S. Patent Publication No. 2003/0162497 to Curtiss et al. (“Curtiss”) further in view of U.S. Patent No. 7,305,254 to Findikli (“Findikli”).

Requests for Compact Prosecution

Applicant respectfully requests compact prosecution in accordance with 37 C.F.R. § 1.104 and M.P.E.P. § 707.07.

Applicant notes that in the Final Office Action dated June 11, 2009, all pending claims were rejected under 35 U.S.C. 103(a) as being unpatentable over Walters in view of Curtiss and further in view of Findikli. In the Reply dated September 17, 2009, Applicant amended the claims and argued, *inter alia*, that the Final Office Action dated June 11, 2009 failed to make a proper *prima facie* case of obviousness because (i) the cited references could not properly be combined, and (ii) the references, taken alone or in combination fail to disclose that if the peripheral device is identified, “automatically mapping from the identified peripheral device to a corresponding one of said resident programs” and if the peripheral is not identified “determining a communication protocol of said peripheral device, wherein the determined communication protocol is used to automatically map to a corresponding one of said resident programs.”

The instant Office Action does not address these arguments. The Office Action states that the arguments “have been considered but are moot in view of the new ground(s) of rejection.” Office Action dated December 10, 2009, pp. 7-8. However, the instant Office Action asserts the same ground(s) to reject the claims as previously asserted in the Final Office Action

dated June 11, 2009. The instant Office Action proffers the same motivation to combine Walters with Curtiss and Findikli as previously proffered in the prior Office Action. *See* Office Action dated December 10, 2009, pp. 4-5 and Final Office Action dated June 11, 2009, p. 4. Both the previous Final Office Action and the instant office action assert that paragraph [0057] of Curtiss discloses that if the peripheral device is identified, automatically mapping from the identified peripheral device to a corresponding one of said resident programs. *See Id.* Both Office Actions also assert that paragraphs [0058-0059] of Curtiss disclose that if the peripheral is not identified determining a communication protocol of said peripheral device, wherein the determined communication protocol is used to automatically map to a corresponding one of said resident programs. *See Id.* Thus, the instant Office Action does not present new grounds of rejection. Since the Examiner failed to address the previous arguments, Applicant is required to present the same arguments again.

First, Applicant argued in response to the Final Office Action dated June 11, 2009, that the combination of Walters with Curtiss and Findikli is improper and fails to render the claims *prima facie* obvious. *See* Amendment/Submission Under Rule 114, dated September 17, 2009, page 10. The instant Office Action fails to address this argument.

Second, Applicant argued in response to the Final Office Action dated June 11, 2009, the Curtiss fails to teach or fairly suggest using the determined communication protocol to automatically map to a corresponding one of the resident programs. *See Id.* at 11. In response to Applicant's arguments, the Office Action states that Applicant made "arguments pertaining to transfer of resident programs" but the arguments are based on limitations not found in the claims. *See* Office Action dated December 10, 2009, p. 8. Applicant respectfully submits that this response mischaracterizes Applicant's argument. Applicant does argue that Findikli fails to teach or disclose transferring a resident program from a peripheral to a mobile device. Thus, at least a portion of Applicant's arguments pertain "to [the] transfer of resident programs." However, Applicant's argument regarding Curtiss rests on the failure of Curtiss to teach or suggest using the determined communication protocol to automatically map to a corresponding one of the resident programs. Applicant submits that the arguments regarding Curtiss do not pertain to the transfer of resident programs. Moreover, in contrast to the assertions made in the Office Action dated December 10, 2009, the arguments regarding Curtiss are based directly on the elements recited in the claims. Consequently, the assertion that "the features upon which applicant relies (i.e., transfer of a resident program) are not recited in the rejected claims" does

not fully address Applicant's arguments. As such, Applicant is not provided the opportunity to meaningfully respond to the Office Action.

The stated goals of the U.S.P.T.O. policy of "compact" prosecution are to provide applicants with *prompt* and *complete* examination of their applications rather than piecemeal prosecution. *See* M.P.E.P. § 707.07(g). Applicant notes that the Office Action mailed on December 10, 2009 is the ninth (9th) action issued in this case, which has now been pending for more than six (6) years. Applicant is eager to resolve the issues related to patentability expeditiously and respectfully requests the opportunity to do so.

Accordingly, Applicant respectfully requests that any subsequent Office Action on the merits specifically address Applicant's arguments, which are repeated more fully below, (i) that a proper *prima facie* case of obviousness cannot be based on the combination of Walters with Curtiss and Findikli, and (ii) that Curtiss does not disclose that if the peripheral device is identified, "automatically mapping from the identified peripheral device to a corresponding one of said resident programs" and if the peripheral is not identified "determining a communication protocol of said peripheral device, wherein the determined communication protocol is used to automatically map to a corresponding one of said resident programs."

Response to rejections under 35 U.S.C. 103(a)

In the Office Action, claims 2-8, 11-13, 15, 18-22, 29-33, and 35-40 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Walters in view of Curtiss further in view of Findikli. Applicant respectfully traverses these rejections on the grounds that (i) Walters cannot properly be combined with Curtiss and Findikli, and (ii) the cited references, taken alone or in combination, fail to teach all the elements of the claims as presently amended.

Improper Combination of References

It is well established law that if a proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). *See also*, M.P.E.P. § 2143.01.

Walters, *as a whole*, is drawn to interfacing a digital camera with a computer or server (the Final Office action cites to the disclosed IBM Thinkpad PC) using interchangeable wireless transmitters as a bridge for a direct wireless uplink so as to provide wireless enabled mass storage for the camera. *See e.g.*, Walters, col. 10, lines 6-11. Applicant submits that Walters

requires device identification in order to work, thus *teaching against* the present invention. *See e.g.*, Walters, FIG. 8, the device ID.

Walters operates on the principle of a device (PC or server) acting as mass storage for a peripheral device (camera) based upon use of a wireless interface. As such, any modification to have the device control communications with the peripheral via a resident program would impermissibly change the principle of operation of Walters. For at least this reason, Applicant respectfully requests withdrawal of the rejections of claims 2-8, 11-13, 15, 18-22, 29-33, and 35-40 under 35 U.S.C. § 103(a).

The Prior Art Fails to Disclose All Claim Elements

As previously argued in response to the Final Office Action dated June 11, 2009, each of independent claims 29, 33, 35 and 36 recite, *inter alia*, that if the peripheral device is identified, “automatically mapping from the identified peripheral device to a corresponding one of said resident programs” and if the peripheral is not identified “*determining a communication protocol* of said peripheral device, wherein *the determined communication protocol is used to automatically map* to a corresponding one of said resident programs,” which is not taught or fairly suggested by the asserted references. *See* Amendment/Submission Under Rule 114, dated September 17, 2009, pp. 10-11.

Both the Final Office Action dated June 11, 2009 and the instant Office Action correctly state that Walters does not teach or suggest “automatically mapping the peripheral device.” *See* Office Action dated December 10, 2009, p. 4 and Final Office Action dated June 11, 2009, p. 3. In order to cure this deficiency of Walters, both Office Actions cite Curtiss. *See Id.* at 4. In particular, the Office Actions cite to paragraphs [0057]-[0059] of Curtiss for alleged disclosure of the claimed elements related to mapping to resident programs based upon identification and non-identification of the peripheral. However, instead of teaching “*determining a communication protocol* of said peripheral device, wherein *the determined communication protocol is used to automatically map* to a corresponding one of said resident programs” when the peripheral is not identified, Curtiss teaches reading the control data from the peripheral and using (mapping to) similar control data on the device to download the control data from the peripheral. Curtiss clearly fails to teach or fairly suggest *using the determined communication protocol to automatically map* to a corresponding one of the resident programs, as presently claimed. Indeed, the Final Office Action also cites to Rathbone with regard to peripheral detection, which teaches use of a default base driver for communication with an unknown peripheral based on a

detected accessory type (similar to step 716 in fig. 6A of Curtiss), whereas the present invention maps to a resident program to control the unidentified peripheral *based on a determined communication protocol*. For at least these reasons, Applicant respectfully submits that Curtiss fails to cure the deficiency of Walters.

The Examiner previously argued that “[n]othing in the claim limitations precludes Findikli from transferring a resident program once it has already been automatically mapped to a particular peripheral.” Applicant respectfully disagrees. As an initial matter, Applicant notes the impossibility of “transferring a resident program” – to be “resident,” the program must reside on the device and cannot therefore be transferred; likewise, if it needs to be transferred, it clearly does not reside on the device and therefore is not “resident.”

Furthermore, using claim 35 as an example, the claim requires:

- that the program be resident on the mobile wireless communication device - “the mobile wireless communication device having an operating system including a computer platform that manages mobile wireless communication device resources and interaction between the mobile wireless communication device and other devices, the computer platform further including a plurality of resident programs each respectively associated with a communication protocol” – such that Findikli could *only* meet the element upon *subsequent* connection after the software has been transferred from the peripheral; and
- that, upon failure to identify the peripheral, using the determined protocol to map to a resident program – “if said peripheral device is not identified, determining a communication protocol of said peripheral device, wherein the determined communication protocol is used to automatically map to a corresponding one of said resident programs” – in Findikli, if the software has been previously transferred to the mobile wireless communication device, the peripheral should be identified – and if not, the software will be *transferred again* such that it could not be resident on the device when the device failed to identify the peripheral in such a manner that it could be mapped thereto at that time.

For any and all of these reasons, Applicant submits that neither Curtiss, nor Findikli cure the deficiencies of Walters. Therefore, Applicant respectfully submits that claims 29, 33, 35 and 36 are allowable over the cited references.

In order to advance prosecution, independent claims 29, 33, 35, and 36 are amended to clarify the recited elements in the invention. Each of independent claims 29, 33, 35 and 36

recite, *inter alia*, that “the one or more resident programs are stored in a memory of the mobile wireless communication device prior to receiving the indication of the start of the communication by the peripheral device” or an analogous element. Support for this amendment may be found in the specification, including paragraph [0018], which states: “The resident application environment interfaces with any resident programs in the memory 32 of the wireless device” and paragraph [0021] which discloses that software applications, including resident programs, may be loaded onto the computer platform of the wireless device at the time of manufacture. The Office Action correctly states that Walters and Curtiss do not explicitly disclose a resident program for controlling communication between a mobile device and a peripheral. *See* Office Action dated December 10, 2009, p. 4. To cure this deficiency, the Office Action cites to Findikli. As the Examiner has identified, Findikli discloses transferring a resident program once it has already been automatically mapped to a particular peripheral.” Office Action dated June 11, 2009, p. 7. In contrast, each of the independent claims are amended to clarify that “the one or more resident programs are stored in a memory of the mobile wireless communication device *prior to receiving an indication of a start of a communication by a peripheral device.*” (Emphasis added). Thus, Findikli teaches away from the claimed invention and fails to cure the deficiencies of Walters and/or Curtiss.

Therefore, Applicant respectfully submit that claims 29, 33, 35 and 36 are allowable over the cited references. Accordingly, Applicant respectfully requests withdrawal of the rejections of claims 29, 33, 35 and 36 under 35 U.S.C. § 103(a). Further, Applicant submit that because claims 2-8, 11-13, 15, 18-22, 30-32, and 37-40 depend from an allowable base claim, they are allowable for at least such reason. Accordingly, Applicant respectfully requests withdrawal of the rejections of claims 2-8, 11-13, 15, 18-22, 30-32, and 37-40 under 35 U.S.C. § 103(a).

CONCLUSION

In light of the amendments contained herein, Applicants submit that the application is in condition for allowance, for which early action is requested.

Please charge any fees or overpayments that may be due with this response to Deposit Account No. 17-0026.

Respectfully submitted,

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